

REMARKS

This is in response to the outstanding Office Action, Paper No. 3, dated September 3, 2003, which required an election among two species identified by the Examiner. Applicant acknowledges the provisional election to continue with the prosecution of Specie I, disclosed in Figs. 1 through 6, inclusive, as made by Applicant's representative, James Dottavio on April 16, 2003, during a telephone conversation with the Examiner. Applicant believes that Claims 1 through 6 read on the elected specie. The election is made with traverse.

It is respectfully submitted that the subject matter of both the species is sufficiently related that a thorough search for the subject matter of any one species would encompass a search for the subject matter of the remaining species. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden.

MPEP §803 states that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (emphasis added).

It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicant and duplicative examination by the Patent Office. Accordingly, Applicant respectfully requests that the Examiner withdraw the restriction requirement.

Claims 7 through 9 have been cancelled without prejudice or disclaimer. The claims now in the application are Claims 1 through 6. Favorable reconsideration of the application, and a Notice of Allowance, is respectfully requested.

In the outstanding office action, the Examiner objected to the paragraph beginning on page 4, line 17, due to an informality. Applicant has amended the paragraph beginning on page 4, line 17 to delete the improper reference to the

numeral 20. Accordingly, the Examiner's objection should be obviated, and Applicant requests withdrawal of the objection.

In the outstanding office action, the Examiner rejected Claims 1, 3, and 4 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2002/0033225 A1 to Becker et al. Applicant respectfully contends that Claim 1 is patentable over Becker et al. and requests withdrawal of the rejection under 35 U.S.C. §102(e).

Becker et al. disclose a method of making a shingle. Contrary to the Examiner's statement that all elements are disclosed in the Becker et al. patent, the discharging of blend drops of at least two color blends onto each lane, wherein at least one of the blend drops discharged onto the overlay lane has a different color blend from the color blends of all the blend drops discharged onto the underlay lane, is not taught or suggested by Becker et al. Therefore, a prima facie case for anticipation has not been made out.

In contrast to Applicant's invention, Becker et al. teach depositing a plurality of color blends (C1 through C4) from box (30) onto zone C (the overlay). Becker et al. then teach depositing from spill box (31) an additional color blend onto Zone C. The additional color blend is defined as an average of the colored granules deposited onto zone C. As disclosed in paragraph 40, the spill box (31) further applies, simultaneously with the application of additional granules to zone C, continuous layers of granules to zones A, B, D, and E. The granules applied to zones A, B, D, and E are described only as low cost granules, not color blends. Becker et al. further do not teach or suggest that the low cost granules have any particular color or combinations of color.

Therefore, Applicant contends that Claim 1 is not anticipated by the reference cited by the Examiner. Accordingly, Applicant requests withdrawal of the rejections under 35 U.S.C. §102(e). Since Claim 1 has been shown to be

patentable over the cited reference, at least for this reason, Claims 2 through 4 are also patentable.

In the outstanding office action, the Examiner rejected Claims 1 through 5 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,235,142 to Koschitzky in view of Becker et al. Applicants contend that Claims 1 through 5 are patentable and request withdrawal of the rejection under 35 U.S.C. §103(a).

It is respectfully submitted that the Office Action does not meet the criteria for establishing a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Further, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See MPEP §2143.

As stated above, Becker et al. disclose a method of making a shingle. Koschitzky also discloses a method of making a shingle. Neither Becker et al., nor Koschitzky however, teach or suggest the discharging of blend drops of at least two color blends onto each lane, wherein at least one of the blend drops discharged onto the overlay lane has a different color blend from the color blends of all the blend drops discharged onto the underlay lane, as recited in Claim 1.

Further, neither Becker et al. nor Koschitzky teach or suggest the discharging of blend drops of at least two color blends onto each lane, wherein each lane has a combination of color blends for the blend drops different from the combination of color blends for the blend drops of the other two lanes, as recited in Claim 5.

Significantly, Koschitzky does not teach or suggest the use of color blends. Koschitzky teaches only that each layer can be a different color. The strips A through E can all be coated with granules of the same color. Alternatively, different colors can be deposited on different lanes (see column 3, lines 29 through 46).

Therefore, contrary to the Examiner's assertion, neither Becker et al., nor Koschitzky, alone or in combination, teach or suggest the invention as recited in Applicant's claims, and a prima facie case of obviousness has not been established. Accordingly, at least for these reasons, Claims 1 and 5 are patentable over the cited references, and Applicant requests withdrawal of the rejections under 35 U.S.C. §103(a). Because Claims 1 and 5 are patentable, at least for this reason, Claims 2 through 4, and 6 are also patentable.

In view of the above remarks, Applicant has shown that the claims are in proper form for allowance, and the invention, as defined in the claims, is neither disclosed nor suggested by the references of record. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the objection and rejections of record, and allowance of all claims.